

REMARKS

Claims 11 to 24 are currently pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the filed Information Disclosure Statements.

Claims 11 to 13, 16 to 18, 20, 21, 23 and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,244,226 (“Bergh”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Also, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As to claim 11, it includes the feature in which “the locking device does not release the pair of wheels again until predefined critical driving state values are undershot at least for a predefined period of time”. The Final Office Action (at pg. 3) conclusorily asserts that Bergh (col. 8, lines 14 to 20) somehow discloses this feature by supposedly providing that a

critical value (17 mph) is undershot for a predefined period of time (deadband time frame), such that the predetermined period of time is the deadband time needed to undershoot the critical driving state value of 20 mph.

In fact, however, the Bergh reference does not in any way disclose a “deadband time frame”, as provided for in the context of the presently claimed subject matter. In this regard, Bergh states that “a ‘deadband’ is provided so that steering is reengaged at a slightly lower speed to avoid unnecessary switching right around the 20 mph setting.” (See col. 8, lines 18 to 20 (emphasis added)). This is because the “deadband” of Bergh does not refer to a time frame -- but rather to a speed range of 17 mph to 20 mph within which the steering is not reengaged despite the critical value of 20 mph being undershot. Therefore, the Bergh device, upon undershooting the first critical driving state value of 20 mph, **does not wait a predefined period of time until reengaging the steering (as with the presently claimed subject matter of claim 11), since it instead waits until a second critical driving state value of 17 mph is reached before the steering is reengaged.**

The Final Office Action (at pg. 6) conclusorily asserts that Bergh uses set point values (20 mph and 17 mph) which generate a range that creates the dead band region for the control of the Bergh locking means to cut-in and cut-out, in which the dead band region is directly proportional to a period of time it takes to reduce the speed which provides a time delay set by the lower predefined set point value and the time period generated in this dead band between these set points values is directly dependant upon and proportional to the set point values.

In fact, however, even if the “the dead band region is directly proportional to a period of time it takes to reduce the speed which provides a time delay set by the lower predefined set point value” (as asserted), this does not establish a “predefined time period”. This is because in Bergh the “period of time it takes to reduce the speed” is a variable. For example, after undershooting the first critical driving state value of 20 mph *it is not certain what time would elapse (depending on road conditions, the brakes, the driver, etc.) between undershooting the first critical driving state value of 20 mph and undershooting the second critical driving state value of 17 mph, in fact the second critical driving state value of 17 mph may never be reached if the vehicle accelerates again. Therefore, this elapsed time is certainly not a “predefined time period” as provided for in the context of the subject matter of claim 11. Furthermore, the Bergh device, upon undershooting the second critical driving*

U.S. Pat. App. Ser. No. 10/549,399
Attorney Docket No. 12841/7
Reply to Final Office Action of November 17, 2009

state value of 17 mph, also does not wait a predefined period of time until reengaging the steering, since the steering is immediately reengaged at that point.

Accordingly, claim 11, as presented, is allowable, as are its dependent claims 12, 13, 16 to 18, 20, 21, 23 and 24.

It is therefore respectfully requested that the anticipation rejections of claims 11 to 13, 16 to 18, 20, 21, 23 and 24 be withdrawn.

Claim 19 was rejected under 35 U.S.C. § 103(a) as obvious over Bergh in view of Buelt, U.S. Pat. No. 6,105,981.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 19 depends from claim 11, and it is therefore allowable for essentially the same reasons, since the secondary Buelt reference does not cure -- and is not asserted to cure -- the deficiencies of the Bergh reference as explained above.

Accordingly, claim 19 is allowable, and it is therefore respectfully requested that the obviousness rejection be withdrawn.

Claims 14 and 22 were rejected under 35 U.S.C. § 103(a) as obvious over Bergh.

Claims 14 and 22 depend ultimately from claim 11, and they are therefore allowable for essentially the same reasons, since the arguments regarding the asserted obviousness of the 3 to 5 second time range do not cure -- and are not asserted to cure -- the deficiencies of the Bergh reference as explained above.

Accordingly, claims 14 and 22 are allowable, and it is therefore respectfully requested that the obviousness rejections of these claims be withdrawn.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 11 to 24 are allowable.

U.S. Pat. App. Ser. No. 10/549,399
Attorney Docket No. 12841/7
Reply to Final Office Action of November 17, 2009

CONCLUSION

It is therefore respectfully submitted that all of claims 11 to 24 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: 1/4/2010

By:

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

NYO1 1865146

CUSTOMER NO. 26646